

### **Amendments of the Drawings**

Please amend FIGS. 2, 3, and 13 of the drawings (sheets 2/12, 3/12, and 9/12, respectively) by embracing the separated parts of each drawing by a bracket. Replacement drawing sheets for each of FIGS. 2, 3, and 13 are attached in an Appendix.

## **REMARKS**

### **Summary of the Office Action**

Claims 1-6 and 30-47 are pending in the above-identified patent application. Of those, claims 1-6, 30, and 39 have been withdrawn from further consideration as being drawn to a non-elected invention.

The drawings have been objected to under 37 C.F.R. 1.84(h)(1) in connection with the exploded views shown in FIGS. 2, 3, and 13.

Claim 39 has been objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form. Claims 40-47 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 31 and 32 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Marchais et al. French Publication No. 2,679,939 ("Marchais"). Claims 31-38 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsueh U.S. Patent No. 5,996,299 ("Hsueh") in view of Mamane International Publication No. WO 95/27834 ("Mamane").

### **Summary of Applicants' Reply**

Applicants have amended claim 31 to more particularly define the present invention. Claims 40-47 have been amended in response to the Examiner's section 112 rejection of the claims. Claim 44 has also been amended to correct a minor clerical error. Claim 39 has been canceled without prejudice.

FIGS. 2, 3, and 13 of the drawings have been amended in response to the Examiner's objection to the drawings under 37 C.F.R. § 1.84(h)(1). Replacement drawing sheets for FIGS. 2, 3, and 13 (sheets 2/12, 3/12, and 9/12, respectively) are submitted herewith as an Appendix to this Reply.

A Supplemental Information Disclosure Statement is being filed concurrently herewith.  
A Petition for a one-month extension of time is also being filed concurrently herewith.

The Examiner's claim rejections under sections 102 and 103 are respectfully traversed.

#### **The Objection to the Drawings**

The Examiner has objected to FIGS. 2, 3, and 13 under 37 C.F.R. § 1.84(h)(1) because the exploded views in each drawings are not bracketed. Accordingly, applicants have amended FIGS. 2, 3, and 13 of the drawings to embrace the separated parts of each drawing by a bracket. The Examiner's objection to the drawings should therefore be withdrawn.

#### **The Objection to Claim 39**

The Examiner has objected to claim 39 under 37 C.F.R. § 1.75(c) as being of improper dependent form. Applicants have canceled claim 39 without prejudice. Applicants reserve the right to pursue claim 39 or an amended version thereof in a continuing application. The Examiner's objection to claim 39 should therefore be withdrawn.

#### **The Section 112 Rejections**

The Examiner has rejected claims 40-47 under 35 U.S.C. § 112, second paragraph, as being indefinite. In response to the Examiner's rejection, applicants have amended claim 40 to clarify that the "building element being a joining clip adapted to mount a panel or bracket to the building element of claim 31" is referring to a "joining clip adapted to mount a panel or bracket to the building element of claim 31." Applicants further submit that claim 40 depends from claim 31, and therefore includes the features of the building element of claim 31 and the additional features of the joining clip of claim 40. Claims 41-47 have been amended to conform

to the amendment to claim 40. Accordingly, the Examiner's rejection of claims 40-47 under section 112 should be withdrawn.

### **The Section 102 Rejection**

Applicants' amended claim 31 is directed toward a building element suitable for use as a stud or mullion. The building element of claim 31 includes a first set of channels spaced from a second set of channels by first and second webs. As amended, claim 31 requires that these features of the building element form a "unitary structure."

Marchais does not disclose a building element that is a "unitary structure" as required by applicants' amended claim 31. In contrast, Marchais discloses two *separate* half-studs 8A and 9B, as shown in FIGS. 1 and 2. Further, Marchais does not suggest that half-studs 8A and 9B can be anything but *separate*. In particular, Marchais discloses that the invention overcomes difficulties in the prior art by "provid[ing] a removable solid-block panel that is easy to adjust during placement." Marchais, p. 2, ll. 18-19 (translated version). This adjustment feature is provided by "a partly-housed half-stud capable of sliding vertically, with friction, in each groove; and linkage means between the body and the half-studs, adaptable to permit said vertical sliding movement with friction." Marchais, p. 2, ll. 24-28 (translated version). Due to the requirement that the half-studs of Marchais be slidable within the groove, applicants submit that Marchais teaches away from providing half-studs 8A and 9B as a "unitary structure." Notably, if the half-studs were joined as a unitary structure, the entire wall of panels would have to be maneuvered into position at one time. This is in stark contrast to the benefit disclosed in Marchais for easy adjustment during placement of a removable solid-block panel.

Accordingly, Marchais fails to show or suggest a building element that is a "unitary structure" as required by applicants' amended claim 31. Thus, for at least this reason, applicants'

amended claim 31 is not anticipated by Marchais, and the rejection of the claim under 35 U.S.C. § 102(b) should be withdrawn. In addition, dependent claim 32 is allowable at least because independent claim 31 is allowable. Accordingly, the Examiner's rejections of claim 32 is moot and should also be withdrawn.

### **The Section 103 Rejection**

#### **Independent Claim 31**

As set forth above, applicants' amended claim 31 is directed toward a building element suitable for use as a stud or mullion. The building element of claim 31 includes a first set of channels spaced from a second set of channels by first and second webs.

The Examiner correctly states that Hsueh fails to disclose a building element in which "the first set of channels is spaced from the second set of channels by first and second webs," as required by applicants' claim 31. However, the Examiner asserts that Mamane discloses this requirement of applicants' claim 31, and that it would be obvious to combine Hsueh with Mamane. Applicants respectfully disagree, and submit that one of skill in the art would not be motivated to combine Hsueh with Mamane.

Under 35 U.S.C. § 103, a patent may not be obtained if the differences between the claimed invention and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. To combine prior art references, there must be some suggestion or motivation, before the invention itself, to make the new combination. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004). This suggestion to combine may come from the references themselves, from the knowledge of those skilled in the art, or based on the nature of the problem to be solved. *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996).

The Examiner asserts that “[i]t would have been obvious to one ordinary skill in the art, at the time the invention was made, to modify the building element of Hsueh having two parallel webs provided between two sets of channels as taught by Mamane for increasing the strength of the building element and providing a stronger support for the building element.” Office Action, p. 6, ll. 7-10. Applicants submit that the Examiner’s motivation is insufficient at least because Hsueh provides no disclosure of a need to increase the strength of skeletal material 1, nor has the Examiner referred to any portion of Mamane providing such a teaching or suggestion. Rather, the problem to be solved in Hsueh is clear: in prior art partition walls, “the sound proof and dust-proof effects are unsatisfactory, and the boards can be easily detached from the wall materials easily [sic].” Hsueh, col. 1, ll. 41-43. Thus, rather than providing any suggestion of a need to increase strength of partition wall supports, Hsueh discloses that the prior art technology lacked proper sound and dust proofing. Mamane discloses means for assembling abutting wall sections. Mamane, English language Abstract. Again, the Abstract of Mamane does not disclose or suggest the beneficial use of two webs to provide additional strength.

Thus, without further explanation or support from the Examiner as to the basis for the asserted motivation to combine Hsueh with Mamane, the combination appears to be based on hindsight reconstruction and is therefore improper. Accordingly, for at least these reasons, the Examiner’s motivation to combine Hsueh with Mamane is insufficient.

Furthermore, applicants submit that the Examiner’s motivation is also insufficient because Hsueh already discloses structures that would likely “increase[e] the strength of the building element,” thereby rendering moot the Examiner’s alleged motivation to combine Hsueh with Mamane. In particular, Hsueh discloses that plates 51 engage grooves 17 to allow for connection of separate skeletal materials 1. FIG. 2 of Hsueh illustrates that the connecting

material 5 of plates 51 extends through grooves 17. These plates 51 would likely provide the very strength that the Examiner asserts would motivate one of skill in the art to combine Hsueh with Mamane. Thus, applicants submit that one of skill would not look to Mamane for “strength” as the Examiner asserts.

Applicants note that while plates 51 engage grooves 17 and extend between frames 14, Hsueh still fails to show or suggest the “first and second webs” required by applicants’ amended claim 31. In particular, in Hsueh, frames 14 are not spaced from each other by plates 51, and therefore Hsueh does not show that “the first set of channels is spaced from the second set of channels by first and second webs” as required by claim 31. Also, skeletal material 1 and plates 51 of Hsueh are not a “unitary structure” as required by claim 31.

Thus, for at least the reasons set forth above, the Examiner’s motivation to combine Hsueh with Mamane is insufficient, and the rejection of claim 31 should be withdrawn. In addition, dependent claims 32-38 and 40-47 are allowable for at least the reasons that independent claim 31 is allowable. Thus, the Examiner’s rejections of these claims are moot and should also be withdrawn.

#### **Dependent Claim 40**

Applicants’ amended claim 40 depends from independent claim 31, and therefore is allowable over the cited references for at least the reasons set forth above in connection with claim 31. Claim 40 also requires the feature of “a joining clip adapted to mount a panel or bracket to the building element of claim 31,” which the combination of Hsueh with Mamane also fails to show or suggest.

The Examiner asserts that Hsueh discloses the joining clip of applicants’ dependent claim 40:

a joining clip having two separated parts (4, 3), the first longitudinally extending part (4) including arms (41) being snap into the channel of the building element for providing co-operating means for mounting the panel to the building element, the first longitudinal extending part (4) having a protrusion (42) to be snap into a channel of the second longitudinally extending part (3) for connecting the joining clip to the panel, and the second part (21) providing means for connecting the joining clip (19) to panel.

Office Action, p. 5, l. 23 to p. 6, l. 4. Applicants respectfully disagree, and submit that the parts of Hsueh that the Examiner alleges to be the first and second parts of applicants' claim 40 -- fastening plate 3 and hold-down strip 4 -- are not "adapted to mate" as required by applicants' claim 40. In particular, hold-down strip 4 merely lies flat along the portion of fastening plate 3 that the strip touches, as shown in FIG. 3 of Hsueh. In fact, without the screw that holds strip 4 to partition 2 (as shown extending through locking holes 21), plate 3 and strip 4 would not even be positioned together. In other words, plate 3 and strip 4 are not "adapted to mate," as such adaptation would require some joining between the parts other than the hold-down strip merely being positioned next to the fastening plate.

Accordingly, for at least this additional reason, applicants' amended dependent claim 40 is patentable over Hsueh in view of Mamane, and the Examiner's rejection of the claim should be withdrawn.

### **Conclusion**

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.



Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Reply are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely applicants' best attempt at providing one or more definitions of what applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that applicants are seeking for this application. Therefore, no estoppel should be presumed, and applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review

of the prosecution history. That is, applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, applicants respectfully submit that the application is in condition for allowance, and that such action is earnestly solicited.

#### **Authorization**

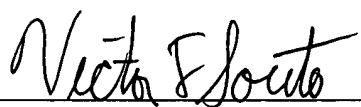
The Director is hereby authorized to charge any additional fees which may be required for this Reply, or credit any overpayment, to Deposit Account No. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Director is requested to grant a petition for that extension of time which is required to make this response timely and is hereby

authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 08-0219.

Respectfully submitted,  
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Date: June 30, 2005

  
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